

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Examiner: Nathan Jeffrey Newhouse

Confirmation No. 8858

Group Art Unit: 3782

CROWN CLOSURE HAVING A
REDUCED RADIUS AND METHOD
OF MANUFACTURE

In re application of:

Carlos Orlando Vilacha Zanoni

Serial No.: 09/745,098

Filed: December 20, 2000

Attorney Docket No. 286765-00001

APPELLANT'S REPLY TO ANSWER

November 3, 2007

Commissioner for Patents
MAIL STOP APPEAL BRIEF - PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Reply to the Examiner's Answer, dated September 18, 2009, in response to the Appeal Brief filed July 8, 2005 and resubmitted September 7, 2007 from the Final Office Action dated March 24, 2005. Appellant notes that since the original filing of the Brief, the Supreme Court issued the decision in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). As this case developed relevant law, Appellant shall address *KSR International* and its applicability to this rejection below.

In the initial portion of the Answer the Examiner has repeated the rejections and associated reasoning as set forth in the Final Office Action. Appellant relies upon the argument set forth in the Appeal Brief as a response to those rejections. The following argument relates to the Examiner's Response to Argument beginning on page 6 of the Answer.

Argument

Claims 1 and 7; Rejected Under 3 U.S.C. § 102(b)

A number of the elements recited in the present claims are not disclosed by *Punte* (U.S. Patent No. 2,327,455). Two such elements, the “serrations” and the “curved portion” of the shell are recited in relation to each other. That is, the claims recite that the “serrations” do not extend into the “curved portion.” The claims further recite that the “curved portion” is adapted to be the same shape as the mouth contour of a bottle. Further, as set forth in the specification, it is this element, the shell being shaped with the contour of the body to which it is affixed, that provides the benefit of resisting slippage during the time the shell is placed on the body but prior to the final, deforming, installation.

As noted in the Appeal Brief, the Examiner asserts that both of these elements, serrations and a curved portion, are disclosed in Figures 2 and 3 of *Punte*. More specifically, the Examiner asserted that the “curved portion” is shown in Figure 3 at “deformation 13,” and that the “serrations” are shown in Figure 2. The Examiner further noted that “clearly Figure 2 of *Punte* shows the serrations (lines in skirt 10) stop short of the curved portion.” As Appellant noted, however, Figure 2 shows the shell prior to the closure being installed and Figure 3 shows the closure after being installed. Appellant further noted that if one were to compare the length of the serrations in Figure 2 (a side view) to the shell in Figure 3 (a cross-sectional view), it is clear that the serrations would extend into the curved portion of the shell. Thus, Appellant noted that the Examiner was attempting to have two separate configurations of the *Punte* device act as a reference for a single configuration of the claimed device.

The Examiner now responds that, despite stating “the crown top ... [and] the skirt are reshaped or deformed as at 13 (curved portion) ...,” the “curved portion” of *Punte* that discloses the recited feature of the present claims is not actually the element disclosed at “13 (curved portion),” but the “portion of *Punte* of the reshaped or deformed portion 13 above the serrations and below the top of the crown closure.” Answer at 7. Appellant relies on the arguments in the Appeal Brief to respond to the Examiner’s original charge. Appellant cannot, however, prevent the Examiner from switching horses in the middle of the stream. Appellant can note, however, that under the Examiner’s new interpretation of the “curved portion,” *Punte* fails to disclose that the “curved portion” “is adapted to be the same shape as the mouth contour of a bottle” as required by the claims.

That is, *Punte* discloses that element 13 is identified as “the sealing portion 8 of the crown top, and the turn thereof at 9 **into the skirt at 10** are reshaped ...to conform to the sealing surface presented by the neck 14 of the bottle” Page 2, Right Col. lines 22-26. Thus, it is all of these pre-deformation elements that “conform to the sealing surface presented by the neck 14 of the bottle.” As the “curved portion,” as newly identified by the Examiner, does not include all of these elements, the “curved portion” cannot be said to be “adapted to be the same shape as the mouth contour of a bottle” as required by the claims.

As noted before and as stated in MPEP §2131:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.... The identical invention must be shown in as complete detail as is contained in the ... claim.

Id., citing (*Verdigaal Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, (Fed. Cir. 1989). It is submitted that upon reading the *Punte* reference, one skilled in the art would not consider having a crown closure wherein the curved portion is adapted to be the same shape as the mouth contour of a bottle and wherein the serrations do not project into the curved portion as set forth in both Claims 1 and 7.

It is further noted that the present application discusses, in the background section, the development of crown closures. In this section of the specification, it is noted that crown closures had coatings, *e.g.* a lacquer, but that “liners” were made of cork or plastic. Such elements are separate, identifiable elements which are different than the shell of the crown closure. Further, *Punte* notes that, [i]t is customary to provide sealing pads or cork or other suitable compressible material ... but it is a purpose of the present invention to provide a crown cap ... without such sealing pad inserts.” *Punte* instead uses a deformable “sealing compound.” Accordingly, it is Appellant’s position that, based on the specification (as well as the cited art) a “liner” for a crown closure is known in the art as a separate semi-rigid structure and not as a “coating.”

Accordingly, Appellant requests that the Examiner’s rejection of Claims 1 and 7 under 35 U.S.C. §102(b) be reversed.

Claims 2-6 and 8-12; Rejected Under 35 U.S.C. § 103(a)

Claims 2-6 and 8-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Punte* (U.S. Patent No. 2,327,455) in view of *Leenaards* (U.S. Patent No. 3,827,594). *Punte* and its failure to disclose the elements of the present invention are discussed above. *Leenaards* discloses a crown closure that is shaped to accommodate a seal that engages the lateral face of the bottle to which the closure is attached. That is, the seal is located between the curved portion of the crown closure and the outer side of the bottle. As such, the curved portion of the shell cannot be structured to have the same shape as the container to which the closure will be attached as the curved portion must be shaped to provide a space for the seal. This space is identified by reference number 18 on Figure 2 and described at Col. 4, lines 3-4. *Leenaards* notes that *after* deformation, *i.e.* the crimping procedure, the closure is shaped to the mouth of the container.

Appellant notes that both the Appeal Brief and the Answer were written before the decision of *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) and address the combination of references under the former “teaching, suggestion, motivation” test. In view of the new and relevant law, Appellant now notes that, in regard to the determination of obviousness under 35 U.S.C. § 103, the Supreme Court has stated that:

Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, *it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does*. This is so because inventions in most, if not all, instances rely on building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

KSR International Co. v. Teleflex Inc., 550 U.S. 398, 418-19 (2007) (emphasis added). In addition, the Supreme Court also noted that:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, *this analysis should be made explicit*. See *In re Kahn*, 441 F.3d 977, 988 (Fed Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, *there must be some articulated reasoning with*

some rational underpinnings to support the legal conclusion of obviousness").

Id., at 418 (emphasis added). It is noted that the Supreme Court included an extended discussion reciting the nature of the inventions disclosed in the prior art and then several paragraphs identifying the rationale and reasons that the cited art could be combined and why one skilled in the art would make such a combination. *Id.* at 407-411, 426-427.

With regard to combining known elements of an invention, the Supreme Court further stated that, "[a] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.*, at 418. This holding comports with *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) which held that, although some of the cited references, individually, may have some of the claimed inventions' features, "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.* at 1075. Instead, to reach the proper conclusion under §103:

The decision maker must step backward in time and into the shoes worn by [a person having ordinary skill in the art] when the invention was unknown and just before it was made. In light of *all* the evidence, the decision maker must then determine whether...the claimed invention as a whole would have been obvious at *that* time to *that* person.

Id. at 1073-74 (emphasis added).

It is further noted that the requirement for an "articulated reasoning" is not a minor point in *KSR Int'l*. The requirement for an "articulated reasoning," or a similar statement, is set forth in no less than three MPEP sections relating to obviousness rejections. See MPEP §§ 2141, 2142, and 2143. More specifically, MPEP § 2141 states, "Office personnel **must** therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include **explicit findings** as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. **Factual findings** made by Office personnel **are the necessary** underpinnings to establish obviousness." (Emphasis added). MPEP § 2142 notes that, "[t]he Federal Circuit has stated that '**rejections on obviousness cannot be sustained with mere**

conclusory statements; instead, there must be some **articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness.’ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).” (Emphasis added). MPEP § 2143 states, “The **key** to supporting any rejection under 35 U.S.C. 103 **is the clear articulation** of the reason(s) why the claimed invention would have been obvious.” (Emphasis added).

Additionally, and as set forth in MPEP §§ 2141.02, a “prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).” Further, “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” See, MPEP 2143.01(V). Finally, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” See, MPEP 2143.01(VI).

When looking at *Punte* and *Leenaards* “as a whole” it is clear that *Punte* is structured to utilize a “coating” as noted by the Examiner while *Leenaards* is structured to use a “sealing member” that is a separate, semi-rigid member as a seal. Thus, the “principle of operation” of the *Punte* device is to have a crown closure that is “padless,” that is, without a liner, or at least a deformable coating, while the “principle of operation” of the *Leenaards* closure requires a lateral liner. Thus, the proposed combination would change the principle of operation of at least one of the *Punte* or *Leenaards* references. As such, the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Further, the Examiner identifies, on page 2, various elements disclosed by *Punte* and *Leenaards*, but then provides a single conclusory sentence describing how/why these references can be combined and stating that such a combination is obvious. Under *Fine*, merely identifying elements as existing in the prior art and stating they can be combined is not sufficient to support a rejection under 35 U.S.C. § 103(a). Further, as the Examiner has only provided one sentence in support of the proposed combination, the Examiner has failed to present an articulated reasoning in

support of the rejection. That is, Appellant asserts that the sentence is the exact type of conclusory sentences that *KSR International* and MPEP § 2142 state cannot, by itself, support a rejection under 35 U.S.C. § 103(a). By providing only these two sentences, the Examiner has failed to provide explicit findings (MPEP § 2141) and failed to provide the “key” support for a finding of obviousness (MPEP § 2143).

Accordingly, not all of the elements of the present claims are disclosed in the cited art. For this reason alone, the proposed combination cannot be used as basis for rejection of Claims 2-6 and 8-12 under 35 U.S.C. § 103(a). Further, the proposed combination would destroy the intended purpose of either *Punte* or *Leenaards*, therefore the combination is improper. Finally, even if the combination were possible, the Examiner has failed to properly support the rejection as required by *KSR International* and 35 U.S.C. § 103(a). Accordingly, Appellant requests that the Examiner’s rejection of Claims 2-6 and 8-12 under 35 U.S.C. §103(a) be reversed.

Claim 13; Rejected Under 35 U.S.C. § 103(a)

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Punte* (U.S. Patent No. 2,327,455) in view of *Ferngren* (U.S. Patent No. 2,099,056). *Punte* and its failure to disclose the elements of the present invention are discussed above. *Ferngren* discloses a flexible plastic cap for a flexible bottle. *See*, Col. 1, lines 40-47. *Ferngren* does not discuss a crown closure. As crown closures and plastic caps are different types of closures, these references cannot be combined.

As anyone who has tried to seal a twist off bottle with a crown closure, or vice-versa, has experienced, the two types of closures are not compatible. That is, each closure operates based on separate mechanics. Those skilled in the art understand that such closures are not combinable without changing the principle of operation of at least one of them. Thus, under MPEP 2143.01(VI), these references cannot be used to establish a *prima facie* case of obviousness.

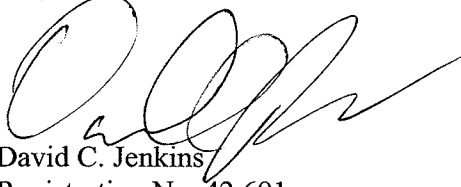
Further, the Examiner has again provided only a list of elements and a single sentence asserting that the art can be combined. Thus, the Examiner has not provided an “articulated reasoning” in support of the rejection.

Accordingly, as the proposed combination would destroy the intended purpose of either *Punte* or *Leenaards*, and, as the Examiner has failed to properly support the rejection as required by *KSR International* and 35 U.S.C. § 103(a), Appellant requests that the Examiner’s rejection of Claim 13 under 35 U.S.C. §103(a) be reversed.

Conclusion

It is submitted that Claims 1-13 are patentable over the prior art. Therefore, Appellant respectfully requests that the Board reverse the Examiner's rejections of Claims 1-13 and remand the application to the Examiner for the issuance of a Notice of Allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David C. Jenkins', is written over the printed name.

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